REMARKS

Status of the Claims

In the Office Action, claims 1-25 are noted as pending in the application. Claims 1-25 stand rejected.

A.   Summary of Cited References

Before addressing the Examiner's rejections, a brief summary of the cited references is provided.

U.S. Patent number 6,603,758 to Schmuelling, et. al. ("Schmuelling")

Schmuelling relates to allowing a user to select a cable modem and internet service provider ("ISP") through which to receive service. Abstract. Sends a list of ISPs to a cable modem for display, so a user can select an authorized ISP from the list. FIG. 2, Col. 3, line 15.

U.S. Patent number 6,195,689 to Bahlmann ("Bahlmann")

Bahlmann relates to controlling network provisioning servers. Abstract.

B.

On page 2 of the Office Action, claims independent claims 1, 13 and 19 are rejected under 35 U.S.C. § 103 as being obvious over Schmueling in view of Bahlmann. The reasons that the claims patentably distinguish over the reference are addressed below.

C.   The Claims are not Obvious over the Cited References

Applicant respectfully submits that the subject matter of the claims patentably distinguish over the cited references. Under MPEP § 2142, for an examiner to establish a *prima facie* case of obviousness, "three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure." If any of these three criteria are not met, the Examiner has not met the burden of establishing a *prima facie* case of obviousness, and the rejection should be withdrawn.

Furthermore, each dependent claim includes all of the limitations of the independent claim from which it depends. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. MPEP §2143.03, citing In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). Applicant respectfully submits that the burden of establishing a *prima facie* case of obviousness has not been met.

D.   Claims are not obvious over the cited references

Claim 1 recites ". . . selecting one or more subsets of a plurality of standardized network equipment configuration parameters . . . ." As discussed in the specification of

the present application, an equipment configuration parameter refers to software switches comprising type length variables ("TLV"). Page 8, lines 6-10. Examiner analogizes the recited network equipment configuration parameters with a list of ISPs.

A subset of configuration parameters and a list of ISPs are not synonymous. As described in the present application, configuration parameters refer to a software switches that enable certain predetermined features and capabilities of corresponding communication devices. For example, if a particular network sever is not capable of supporting 911 emergency service, then TLVs representing parameters related to 911 features are not provisioned into another device that may communicate with the server. Page 8, lines 12-17. The TLVs set software "switches" that enable a network device, such as a cable modem, to perform certain features that are a subset of a larger group of features, for example, the PacketCable specification. Using the claimed subject matter provides the advantage that a software designer does not have to modify the cable modem's operating software code at the source code level to work around non-support of certain features that are not implemented by a particular equipment vendor. This is not the same as facilitating the selection of an ISP after two networking devices have established communication.

The specification highlights the fact that the subset of features corresponds to software that operates a hardware device rather than corresponds to a list of service providers, which is what the section of the reference Examiner refers to discusses. Certain equipment vendors (vendors of networking hardware devices) may support certain subsets of a large set of PacketCable features, for example Page 8, lines 3-21. Support may be determined based on certain circuitry or processor devices with the networking hardware device, such as, for example, a cable modem termination system, that provides telephony services.

The specification of Schmuelling discusses merely providing a list of available service providers to a cable modem. It will be appreciated that selecting from a list of available ISPs, which Examiner points out as being illustrated by steps 212-22, occurs after connection between the cable modem and CMTS occurs at step 202. Col. 3, lines 44-48. The configuring of a network device, i.e. a cable modem ("CM"), as recited in claim 1 of the present application occurs during setup of communication between the CM and CMTS. It is configuration of the operating system that the recited steps in claim 1 relate to. Page 8, lines 3-21. The CM does not perform the selecting of an ISP, which is discussed in Schmuelling, until it loads its operating system and establishes communication with the CMTS. Schmuelling clearly shows this step occurring before the steps of selecting from the list of ISPs.

Moreover, Schmuelling only discusses the general process that a CM establishes communication with a CMTS. Col. 3, lines 44-48. Schmuelling does not discuss the selectable capability of configuring a network device for operation with the CMTS in the communication network. Thus, the reference does not disclose the element recited in claim 1 of ". . . selecting one or more subsets of a plurality of standardized network equipment configuration parameters . . . ." Indeed, if the ISP list sent at step 212 in Schmuelling were used in deliver configuration information, the list of available ISPs would not be available Schmuelling to provide information for configuring the CM for communication with the CMTS, the

Furthermore, the Bahlmann reference is cited by Examiner, who states that Bahlmann "suggests saving and loading the configuration file . . . from the server to the first network device and setting software switches within the first network device based on the configuration file." Thus, Examiner does not rely on Bahlmann as a reference against the step recited in claim 1 of selecting one or more subsets of a plurality of standardized network equipment configuration parameters by setting a variable to a certain value corresponding to the subset. Since the element recited in claim 1 is not found in Schmuelling or Bahlmann, the references do not disclose all elements of claim 1. In addition, the infrastructure in Schmuelling cannot work as described therein if the list sent at step 212 is the same as the equipment parameters. Thus, there is not a likelihood of success in combining the references. Lastly, there is not a suggestion in the references, or knowledge in the art to combine the references because neither reference mentions a device that is configurable according to the vendor of another device with which it will communicate. Accordingly, Examiner has not made out a prima facie case of obviousness. Therefore, Applicant respectfully requests withdrawal of the rejection. Similar analysis applies with respect to independent claims 13 and 19. Withdrawal of the rejection is respectfully requested.

With respect to claim 8, neither reference discloses the method "wherein the communication features facilitate communication between the first network device and a second network device." The list of ISPs sent at step 212 cannot facilitate communication between the CM and CMTS because, as shown in the figures of Schmuelling, communication is established between the CMTS and CM at step 202 in FIG. 2, step 401 in FIG. 4 and step 501 in FIG. 5. The list in Schmuelling is sent after communication is established. Therefore, combining the steps shown in the references would not successfully result in achieving the subject matter recited in claim 8.

Examiner rejects claims 6 and 16 because Bahlmann discusses a trivial file transfer protocol ("TFTP") server, which FIG. 2 shows as item 220. TFTP server 220 is a software block that connects with API 214, which presumably stands for application program interface. As discussed above, Schmuelling discusses sending a list of ISPs to a user device after the device has established communication with a CMTS. Thus, the TFTP server in Bahlmann cannot be used with providing the list of ISPs as discussed in Schmuelling to configure a network device to enable communication as claimed in the claims.

Regarding claim 5, Examiner has not given a reason why it would be obvious to use a personal digital assistant as the computeing device. Withdrawal of the rejection is respectfully requested.

Having significance to the remainder of the rejected claims, the independent claims, analyzed above, patentably distinguish over the references as discussed above. All of the dependent claims depend from their corresponding independent claims and therefore contain all of the limitations contained in their respective base claims. Accordingly, under MPEP §§2142 §2143.03, these dependent claims also patentably distinguish over the references and withdrawal of the rejection is respectfully requested.

Furthermore, except for claims 5, 6 and 16, Examiner rejects all of the dependent claims without providing supporting the assertion as to why it would be obvious to combine the references. Examiner merely asserts that an element of a given dependent

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claim is found in one of the references and therefore the claim is obvious. Such piecemeal evaluation is not permitted.

"Examiner [is not permitted] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). "[E]xaminer must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. Id. "Because the [Examiner] did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of [the present] [application] to make the combination, [an inference is drawn] that the examiner selected these references with the assistance of [forbidden] hindsight." Id. at 1358.

Examiner has not stated any motivation or suggestion to combine Bahlmann with Schmuelling to arrive at the claimed combination in these dependent claims. Thus, the listing of the claim elements and providing a corresponding alleged analogy thereto appears to be an instance of using Applicant's claim as a blueprint for combining references. Since this is not permitted under In re Rouffet, withdrawal of the rejection is respectfully requested.
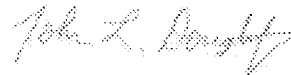
SUMMARY

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and that action is earnestly solicited.

If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any informalities that can be corrected by an Examiner's amendment please contact the undersigned at the mailing address, telephone, facsimile number, or e-mail address indicated below.

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